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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,698	07/20/2001	Makoto Tomita	35.G2865	9013

5514   7590   05/03/2005

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NEW YORK, NY 10112

EXAMINER
EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *19 and 20* is/are allowed.

6)☒ Claim(s) *1-18 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claim1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al

(U.S. patent 6,665,081) in view of Dennis et al (U.S. patent 5,471,564)

Regarding claim 1,7 and 13 Suzuki et al disclose: An information processing

apparatus comprising: development mode deciding means for automatically deciding

which one of development modes is used (please note column 6 lines 8-18 and column

2 lines 44-54 where the automatic mode is selected and applied) including a vector

mode (please note column 6 lines 8-18 where the one of the mode chosen is the PDL or

vector mode) in which printing data described in the printer control language to be

developed into image data by a printing device is created (please note column 5 lines

44-56 where the PDL data is created by the application on the computer 1 and through

the printer driver is sent to the printer 3) and an image mode (please note column 11

lines 13-14 where the image mode or in this case the driver page mode since this mode

does the bit map graphic printing) in which printing data described in an image mode to

be used in printing by said printing device is created (please note column 11 lines 16)

However Suzuki et al do not quite disclose: print setting deciding means for

automatically deciding a plurality of print setting items in the printing data to be

instructed to said printing device when the printing data is created in the development

mode decided by said development mode deciding means. On the other hand Dennis et

al disclose: print setting deciding means for automatically deciding a plurality of print

setting items in the printing data to be instructed to said printing device when the

printing data is created in the development mode decided by said development mode

deciding means (please note column 11 lines 8-36 where the resources are stored in

the within the host and any alteration or editing done by the user before the printing will

be inserted in, column 1 lines 16-19 and column 12 lines 37-57 where the user setting

in terms of different font was pulled and inserted in the document, and also note column

23 lines 59-67 and column 24 line 1-7 where the mode for the printing is switch back

and fort to get the proper mode of operation) Therefore it would have been obvious to a

person of ordinary skill in art at the time of the invention to modify Suzuki et al's

invention according to the teaching of Dennis et al , Where Dennis et al in the same

filed of endeavor teach the way the print data edited and customized by the user just

before sending to be printed for the purpose of making the process or printing more

effective in terms of having user making adjustment just before the actual printing.

Regarding claim 2,8 and 14 Suzuki et al disclose: An information processing

apparatus according to claim 1, further comprising: spool means for spooling as

intermediate data (please Suzuki et al, note Fig.2 item 35 the spooler, column 6 lines

52-54) a printing instruction received from an application via an OS (please note column

6 lines 53-55) and discriminating means for analyzing the spooled intermediate data

and discriminating characteristics of information to be printed (please note column 10

lines 31-56) wherein said development mode deciding means and said print setting

deciding means make decisions in accordance with the characteristics of the

information to be printed which have been discriminated by said discriminating means

(please note Dennis et al, column 11 lines 8-36 where the resources are stored in the

within the host and any alteration or editing done by the user before the printing will be

inserted in, column 1 lines 16-19 and column 12 lines 37-57 where the user setting in

terms of different font was pulled and inserted in the document, and also note column

23 lines 59-67 and column 24 line 1-7 where the mode for the printing is switch back

and fort to get the proper mode of operation)

Regarding claim 3,9 and 15 Suzuki et al disclose: An information processing

apparatus according to claim 1, wherein said development mode deciding means

includes an option for designating one of the development modes including said vector

mode (please note column 6 lines 8-18 where the one of the mode chosen is the PDL or

vector mode) and said image mode (please note column 11 lines 13-14 where the

image mode or in this case the driver page mode since this mode does the bit map

graphic printing) and an option for designating an automatic selection mode of

automatically deciding which one of the development modes is used one of said two

options being able to be manually designated (please note column 6 lines 8-18 and

column 2 lines 44-54 where the automatic mode is selected and applied)

Regarding claim 4,10 and 16 Suzuki et al disclose: An information processing

apparatus according to claim 3, wherein, in said development mode deciding means,

the option for designating the automatic decision mode is set to an initial default (please note column 6 lines 8-18 and column 2 lines 44-54 where the automatic mode is selected and applied)

Regarding claim 5 ,11 and 17 Suzuki et al disclose: An information processing apparatus according to claim 1, further comprising: printing data creating means for creating, in the development mode, printing data that includes print setting information designated by the print setting items containing at least one of printing resolution, printing gradation and shade (please note column 13 lines 1-4).

Regarding claim 6, 12 and 18 Dennis et al disclose: An information processing apparatus according to claim 5, further comprising: transmission processing means for controlling a process of transmitting the printing data created by said printing data creating means to said printing device via a network (please note column 25 lines 57-67 and column 26 lines 1-11).

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1.   Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied in the computer readable medium to realize the computer program functionality , the claimed subject matter is non-statutory . See MPEP 2106 IV.B.1.

Allowable Subject Matter

4.   Claim 19-20 are allowed.

The prior art of record fails to teach or suggest that said automatic decision mode is

selected, does not accept the setting made by user on those of said plurality of print

setting items that should be automatically decided in said automatic decision mode but

accept the setting made by users on those print setting items that are allowed for users

to set.

Contact Information

> Any inquiry concerning this communication or earlier communications from the
>   examiner should be directed to *Said Ebrahimi-Dehkordy* whose telephone number is
>   (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to

5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

        Assistant Commissioner for Patents
        Washington, D.C. 20231
Or faxed to:
        (703) 872-9306, or (703) 308-9052 (for *formal* communications; please
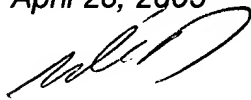   mark
        "EXPEDITED PROCEDURE")

Or:

        (703) 306-5406 (for *informal* or *draft* communications, please label
        "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
April 28, 2005

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER